#10/Election

00862.022116

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	:	Examiner: M. Gart
KAZUMA SAT0, et al.	)	
	:	Group Art Unit: 3625
Application No.: 09/781,162	)	
	:	
Filed: February 13, 2001	)	
	:	
For: EXPENDABLE MANAGEMENT METHOD AND SYSTEM	)	
	:	April 2, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SECOND RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the Restriction Requirement dated March 23, 2004, Applicants hereby reaffirm their earlier election of the Group I claims, namely Claims 1 to 24. The election is made with traverse.

Traversal is on two grounds: first, the Examiner has not met his burden for proving distinctness; and second, the Examiner has not met his burden of establishing reasons for insisting upon restriction. See MPEP § 808:

> "Every requirement to restrict has two aspects: (a) the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are either independent or distinct; and (b) the reasons for insisting upon restriction therebetween as set forth in the following sections."

With regard to the failure to carry the burden for proving distinctness, the Examiner relies § 806.05(d) in his assertion that the groups are related as subcombinations usable together. While it is true that only one-way distinctness need be shown, the examples provided in the Restriction Requirement do not establish that the asserted separate utility[1/] were not in fact also encompassed by both of the allegedly distinct groups. Thus, since the Restriction Requirement did not also assert that the allegedly separate utilities were not encompassed by each group, the Examiner failed to meet his burden of proving distinctness.

With regard to the reasons for insisting upon restriction, the Examiner asserted that each of the groups had acquired "a separate status in the art because of their recognized divergent subject matter", relying on MPEP § 808.02(B). Importantly, however, the Restriction Requirement classified each of the three groups into identical classes and subclasses, namely Class 705, Subclass 26. Accordingly, to establish a separate status in the art, evidence must be provided to show a recognition of separate inventive effort. Such evidence might be in the form of a citation to patents which evidence such separate status, but since no evidence at all was provided, the Restriction Requirement is faulty.

Accordingly, reconsideration and withdrawal of the Restriction Requirement is respectfully requested, together with an examination of all of Claims 1 to 34 on the merits.

[1/]The asserted separate utilities were "managing maintenance agreements" with respect to groups 1 and 2 and 1 and 3; and "executing processing related to an expendable used" with regard to groups 2 and 3.

Finally, the Restriction Requirement indicates that a request was made for an oral election, "but did not result in an election being made". Actually, Applicants' attorney complied fully with the Examiner's request for an oral restriction requirement, and left a telephone message with the Examiner on March 22, 2004, which was the date on which the Examiner had requested an oral response. In addition, since the attorney was unable to reach the Examiner orally, the attorney also filed (by facsimile) a Response To Telephonic Restriction Requirement on March 22, 2004, a date which is a date which predates the mailing date of the instant Restriction Requirement. Accordingly, it is incorrect to state that, as was stated in the Restriction Requirement, that an oral request for election "did not result in an election being made".

Applicants' undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

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